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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,127	11/25/2003	Herbert Eichenauer	PO-7827/LeA 36,408	6193
157 7590 03/13/2009 BAYER MATERIAL SCIENCE LLC 100 BAYER ROAD PITTSBURGH, PA 15205			EXAMINER MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			03/13/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/721,127	Applicant(s) EICHENAUER ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 12-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyatake et al. (US 6,822,045).

Patentees disclose a process in which a latex “A” (referred to as a “silicone rubber” but containing both containing acrylic as well as crosslinked silicone polymers) are coagglomerated with a latex “B” while conducting polymerization of vinyl rubbers, i.e. grafting is taking place during coagglomeration and as such the graft copolymers formed during the process would be coagglomerated. Note the Abstract in this regard. Redox polymerization is preferred for production of “B” at column 10, lines 41-43. Both “A” and “B” may be crosslinked at column 7, lines 17-20 as well as column 9, lines 33-36. It is noted that applicants "consisting of" language only pertains to materials used in a redox system and do not exclude materials present in non redox systems such as may possibly be present in patentees' final cografting step. In any case no evidence has been presented that the products of redox and non redox persulfate polymerization

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differ and as both types of systems result in addition polymerized acrylates the product of patentees and applicants would reasonably appear to be the same.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Claims 1-10 and 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyatake et al. (US 6,822,045).

No examples of processes having all of applicants limitations including use of redox polymerization to produce patentees' "B" which applicants may argue has a material effect on the product produced as compared to non redox or use of combinations of redox, non redox polymerization. However choice of applicants various limitations from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Applicant's arguments filed 1-9-09 have been fully considered but they are not persuasive.

Applicants argue that each element of the claim must be present in a reference. However polymerization of rubbers separately is not an element of the instant claims which recite no such limitation. Limitations not present in the claims are given no weight. Patentees disclose that at least two kinds of polymer particles are present prior to agglomeration (column 11, lines 50-54) despite formation of two lattices at the same time. The co-agglomerated lattices of the patent Examples are still in latex form and any coagglomerated latex particle is a mixture of different lattices. Whether or not applicants agree with this "COMPARATIVE EXAMPLE 1" in column 18 of the patent is not co-agglomerated before co-precipitation and it is therefore not clear how the limitation that "each of the rubbers undergoes polymerization separate from the other" would distinguish over the comparative Example even if such a limitation were present in the claims. Lastly, while it appears that all elements of applicants process steps are disclosed by the references, applicants are claiming a product not a process and it is immaterial that process steps not resulting in product differences may not be present.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis M-F, 9-5pm at telephone number 571 272 1075.

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Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

JCM

3-10-09.

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796